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Filing date: **07/27/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---|---|
| Proceeding | 91221913 |
| Party | Defendant<br>Arduino, LLC |
| Correspondence Address | MARTIN SCHWIMMER<br>LEASON ELLIS LLP<br>1 BARKER AVE FL 5<br>WHITE PLAINS, NY 10601-1523<br>UNITED STATES<br>tmdocket@leasonellis.com, levin@leasonellis.com, schwimmer@leasonellis.com |
| Submission | Other Motions/Papers |
| Filer's Name | Michelle Levin |
| Filer's e-mail | levin@leasonellis.com, tmdocket@leasonellis.com, schwimmer@leasonellis.com |
| Signature | /Michelle Levin/ |
| Date | 07/27/2015 |
| Attachments | Applicant's Reply to Opposer's Response (01348892).pdf(216038 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

| | |
|---|---|
| Arduino S.r.l.,<br><br>Opposer,<br><br>v.<br><br>Arduino, LLC,<br><br>Applicant. | Opposition No. 91221913<br>Application No. 86392678<br><br>Mark: ARDUINO YÚN |

**APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO CONSOLIDATE AND SUSPEND**

Applicant, Arduino, LLC ("Applicant"), by and through its attorneys, Leason Ellis LLP, submits this Reply to Opposer's Response To Applicant's Motion to Consolidate and Suspend, in order to bring to the Board's attention two facts that weren't available to Opposer when it filed its Response.

The Board today mailed its decision to consolidate and suspend Opposition no. 91221050 and Cancellation no. 92060077. The consolidated cases will be maintained as Opposition no. **91221050** as the "parent case."

Second, Opposer, in its response, indicates in paragraph 4, referring to the parallel civil action between the parties, that "Applicant has not completed service against Opposer under the Hague Convention." While, to the best of Applicant's knowledge, Opposer has not yet been served under the Hague Convention, nevertheless such service had been requested, and is pending. See Exhibit A, "Applicant's request for service abroad of judicial or extrajudicial documents," dated June 10, 2015.

Accordingly, based on the foregoing, Applicant respectfully reaffirms its request that the Board consolidate Proceeding Nos. 91221050 and 91331913 and stay these proceedings pending the final determination of the Civil Action.

Dated: July 27, 2015
White Plains, New York

Respectfully submitted,

Martin Schwimmer
Michelle Levin

LEASON ELLIS LLP
One Barker Avenue, Fifth Floor
White Plains, New York 10601
Tel.: (914) 821-8011
Fax: (914) 288-0023
Email: Schwimmer@leasonellis.com

*Attorneys for Applicant*

## CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing RESPOPNSE TO OPPOSER'S REPLY TO APPLICANT'S MOTION TO CONSOLIDATE AND SUPSEND was served upon counsel for Arduino S.r.l. on this 26th day of July2015 by first-class mail, postage prepaid, addressed as follows:

PAOLO A STRINO
Gibbons P.C.
One Pennsylvania Plaza 37th Floor
NEW YORK, NY 10119-3701
UNITED STATES

Michelle Levin

# EXHIBIT A

# REQUEST
# FOR SERVICE ABROAD OF JUDICIAL OR EXTRAJUDICIAL DOCUMENTS

DEMANDE AUX FINS DE SIGNIFICATION OU DE NOTIFICATION A L'ÉTRANGER D'UN ACTE JUDICIAIRE OU EXTRAJUDICIAIRE

**Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters, signed at The Hague, the 15th of November 1965.**
Convention relative à la signification et à la notification à l'étranger des actes judiciaires ou extrajudiciaires en matière civile ou commerciale, signée à La Haye le 15 novembre 1965.

| **Identity and address of the applicant**<br>Identité et adresse du requérant | **Address of receiving authority**<br>Adresse de l'autorité destinataire |
|---|---|
| Martin Schwimmer, Esq.<br>Attorney at Law<br>Leason Ellis LLP<br>One Barker Ave, Fifth Floor<br>White Plains, NY 10601<br>USA<br><br>Phone: +1 914-821-8011<br>Fax: +1 914-288-0023<br>Email: schwimmer@leasonellis.com | Ufficio Unico Ufficiali Giudiziari<br>presso la Corte d'Appello di Roma<br>Via Viale Giulio Cesare, 59<br>00195 ROME<br>Italia<br><br>Phone: +39 063283 67058<br>Fax: +39 063283 67933<br>Email: unep.ca.roma@giustizia.it |

**The undersigned applicant has the honour to transmit – in duplicate – the documents listed below and, in conformity with Article 5 of the above-mentioned Convention, requests prompt service of one copy thereof on the addressee, i.e.:**
Le requérant soussigné a l'honneur de faire parvenir – en double exemplaire – à l'autorité destinataire les documents ci-dessous énumérés, en la priant, conformément à l'article 5 de la Convention précitée, d'en faire remettre sans retard un exemplaire au destinataire, à savoir :

**(identity and address)**
(identité et adresse)
Arduino S.r.l.
Via Romano, 12
10010 Scarmagno (TO)
Italia
Phone: +39 0125633702
Email (PEC): smart@smartprojects.it

| | | |
|---|---|---|
| ☒ | *a)* | **in accordance with the provisions of sub-paragraph *a)* of the first paragraph of Article 5 of the Convention***<br>selon les formes légales (article 5, alinéa premier, lettre *a*)* |
| ☐ | *b)* | **in accordance with the following particular method (sub-paragraph *b*) of the first paragraph of Article 5)*:**<br>selon la forme particulière suivante (article 5, alinéa premier, lettre *b*)* :<br>____ |
| ☐ | *c)* | **by delivery to the addressee, if he accepts it voluntarily (second paragraph of Article 5)***<br>le cas échéant, par remise simple (article 5, alinéa 2)* |

**The authority is requested to return or to have returned to the applicant a copy of the documents - and of the annexes* - with the attached certificate.**
Cette autorité est priée de renvoyer ou de faire renvoyer au requérant un exemplaire de l'acte - et de ses annexes* - avec l'attestation ci-jointe.

***List of documents** / Énumération des pièces*

- Summons
- First Amended Complaint (with Exhibits)

* if appropriate / s'il y a lieu

| **Done at** / Fait à White Plains, NY (USA).<br>**The** / le 10 June Day of May, 2015 | **Signature and/or stamp**<br>Signature et / ou cachet<br>Martin Schwimmer, Esq<br>Attorney<br>MARTIN SCHWIMMER |
|---|---|

# CERTIFICATE
## ATTESTATION

**The undersigned authority has the honour to certify, in conformity with Article 6 of the Convention,**
L'autorité soussignée a l'honneur d'attester conformément à l'article 6 de ladite Convention,

☐ **1. that the document has been served***
que la demande a été exécutée*

| | |
|---|---|
| **– the (date)** / le (date): | ____ |
| **– at (place, street, number):** à (localité, rue, numéro) : | ____ |

| | |
|---|---|
| **– in one of the following methods authorised by Article 5:** dans une des formes suivantes prévues à l'article 5 : | |
| ☐ | *a)* **in accordance with the provisions of sub-paragraph *a)* of the first paragraph of Article 5 of the Convention*** selon les formes légales (article 5, alinéa premier, lettre *a*)* |
| ☐ | *b)* **in accordance with the following particular method*:** selon la forme particulière suivante* : ____ |
| ☐ | *c)* **by delivery to the addressee, if he accepts it voluntarily*** par remise simple* |

**The documents referred to in the request have been delivered to:**
Les documents mentionnés dans la demande ont été remis à :

| | |
|---|---|
| **Identity and description of person:** Identité et qualité de la personne : | ____ |
| **Relationship to the addressee (family, business or other):** Liens de parenté, de subordination ou autres, avec le destinataire de l'acte : | ____ |

☐ **2. that the document has not been served, by reason of the following facts*:**
que la demande n'a pas été exécutée, en raison des faits suivants*:

____

☐ **In conformity with the second paragraph of Article 12 of the Convention, the applicant is requested to pay or reimburse the expenses detailed in the attached statement*.**
Conformément à l'article 12, alinéa 2, de ladite Convention, le requérant est prié de payer ou de rembourser les frais dont le détail figure au mémoire ci-joint*.

***Annexes** / Annexes*

| | |
|---|---|
| **Documents returned:** Pièces renvoyées : | ____ |
| **In appropriate cases, documents establishing the service:** Le cas échéant, les documents justificatifs de l'exécution : | ____ |

* if appropriate / s'il y a lieu

| | |
|---|---|
| **Done at** / Fait à ____<br>**The** / le ____ | **Signature and/or stamp** Signature et / ou cachet |

# SUMMARY OF THE DOCUMENT TO BE SERVED
ÉLÉMENTS ESSENTIELS DE L'ACTE

**Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters, signed at The Hague, the 15th of November 1965 (Article 5, fourth paragraph).**

Convention relative à la signification et à la notification à l'étranger des actes judiciaires ou extrajudiciaires en matière civile ou commerciale, signée à La Haye le 15 novembre 1965 *(article 5, alinéa 4).*

| | |
|---|---|
| **Name and address of the requesting authority:**<br>Nom et adresse de l'autorité requérante : | Martin Schwimmer, Esq.<br>Attorney at Law<br>Leason Ellis LLP<br>One Barker Ave. Fifth Floor<br>White Plains, NY 10601<br>USA<br><br>Phone: +1 914-821-8011<br>Fax: +1 914-288-0023<br>Email: schwimmer@leasonellis.com |

| | |
|---|---|
| **Particulars of the parties*:**<br>Identité des parties* : | Plaintiff:<br>Arduino, LLC<br>72 Oak Street, #4<br>Somerville, MA 02143<br><br>Defendants:<br>Arduino S.r.l. f/k/a Smart Projects S.r.l., Gianluca Martino, Gheo SA, CC Logistics LLC, Magyc Now Ltd., Dog Hunter Inc., Dog Hunter LLC, Dog Hunter AG, Tulyp Holding SA, Federico Musto |

* If appropriate, identity and address of the person interested in the transmission of the document
S'il y a lieu, identité et adresse de la personne intéressée à la transmission de l'acte

☒ **JUDICIAL DOCUMENT****
ACTE JUDICIAIRE**

| | |
|---|---|
| **Nature and purpose of the document:**<br>Nature et objet de l'acte : | The First Amended Complaint attached hereto has been filed with the United States District Court, District of Massachusetts and this document initiates a lawsuit against the named Defendants including Arduino S.r.l. |
| **Nature and purpose of the proceedings and, when appropriate, the amount in dispute:**<br>Nature et objet de l'instance, le cas échéant, le montant du litige : | The First Amended Complaint attached hereto alleges causes of action arising out of copyright infringement, trademark infringement, unfair competition, and breach of contract, all arising under United States federal law and/or Massachusetts' state law. Further, the Complaint seeks a declaration of ownership of the ARDUINO trademark worldwide. |
| **Date and Place for entering appearance**:**<br>Date et lieu de la comparution** : | This case is pending in the United States District Court for the District of Massachusetts and has been assigned Docket Number 1:15-cv-10181-DJC. An Answer to the First Amended Complaint must be filed within 21 days from the date of service, unless an extension is sought and granted. |
| **Court which has given judgment**:**<br>Juridiction qui a rendu la décision** : | N/A |
| **Date of judgment**:**<br>Date de la décision** : | N/A |
| **Time limits stated in the document**:**<br>Indication des délais figurant dans l'acte** : | N/A |

** If appropriate / s'il y a lieu

☐ **EXTRAJUDICIAL DOCUMENT****
ACTE EXTRAJUDICIAIRE**

| | |
|---|---|
| **Nature and purpose of the document:**<br>Nature et objet de l'acte : | — |
| **Time-limits stated in the document**:**<br>Indication des délais figurant dans l'acte** : | — |

** If appropriate / s'il y a lieu

**Michelle Levin**

**From:** trackingupdates@fedex.com
**Sent:** Monday, June 15, 2015 11:35 AM
**To:** Katherine D. Lee
**Subject:** FedEx Shipment 773814911987 Delivered

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# Your package has been delivered

## Tracking # 773814911987

Ship (P/U) date:
Thursday, 6/11/15

**KATHERINE LEE**
LEASON ELLIS LLP
WHITE PLAINS, NY
10601
US

Delivered

Delivery date:
Monday, 6/15/15
12:35 PM

**UFFICIO UNICO**
**UFFICIALI GIUDIZIARI**
PRESSO LA CORTE
D'APPELLO DI ROMA
VIA VIALE GIULIO
CESARE, 59
ROME, 00195
IT

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| **Tracking number:** | 773814911987 |
| **Status:** | Delivered: 06/15/2015 12:35 PM Signed for By: co stamp |
| **Reference:** | 08126/609122-000 |
| **Signed for by:** | co stamp |
| **Delivery location:** | ROME, |
| **Delivered to:** | Mailroom |
| **Service type:** | FedEx International Priority |
| **Packaging type:** | FedEx Box |
| **Number of pieces:** | 1 |
| **Weight:** | 2.50 lb. |

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| **Special handling/Services:** | Deliver Weekday |

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